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EXAMINER

AUGUSTINE, NICHOLAS

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,344	Applicant(s) DANIELL ET AL.	
	Examiner NICHOLAS AUGUSTINE	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- A. This action is in response to the following communications: Request for Continued Examination filed 02/01/2008.
- B. Claims 1-23 remains pending.

Continued Examination Under 37 CFR 1.114

- C. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/01/2008 been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 7, 9-10, 14, 16-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul et al. (US Pub 2002/0087645), herein referred to as Ertugrul in view of Lehman (Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>), herein referred to as Lehman.

As claim 1, Ertugrul teaches a method comprising: providing an email compose interface for composing an email message (fig. 2, label 200; par [0034]), the email compose interface configured to designate at least one email recipient (fig. 2, label 212; par [0035], lines 2-4), the email compose interlace including an email send option for sending the email message (par [0025], lines 11-13; par [0028], lines 9-11, that by pressing the button, the email will be sent out) to the email recipient (fig. 8, labels 802, 806; par [0100], lines 1-5), the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically

launching an IM session in response to selection of the launch IM option (fig. 2, labels 202,214; par [0032-33, 40, 43 and 93) receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface (par [0100], lines 3-12; par [0104], lines 14-17). Ertugrul does not teach receiving an indication to save an IM chat transcript of the IM chat session and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript. However Lehman teaches receiving an indication to save an IM chat transcript of the IM chat session (page 10 - fig. 105) and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript (page 10 - fig. 104).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul by receiving an indication to save an IM chat transcript of the IM chat session and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript as taught by Lehman in order to provide a reminder/option to save a historical record of the IM chat session.

As claim 9, Ertugrul teaches a Computer-readable storage medium encoded with instructions for execution (fig. 1, label 1; par [0030]; par [0040], that a client computer and server contain a storage medium encoded with instructions), comprising: computer-readable code adapted to instruct a programmable device to provide an email compose interface for composing an email message (fig. 2, label 200; par [0034]), the email compose interface configured to designate at least one email recipient (fig. 2,

label 212; par [0035], lines 2-4), the email compose interlace including an email send option for sending the email message (par [0025], lines 11-13; par [0028], lines 9-11, that by pressing the button, the email will be sent out) to the email recipient (fig. 8, labels 802, 806; par [0100], lines 1-5), the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option (fig. 2, labels 202,214; par [0032-33, 40, 43 and 93) receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface (par [0100], lines 3-12; par [0104], lines 14-17). Ertugrul does not teach a computer-readable code adapted to instruct a programmable device to receive an indication to save an IM chat transcript of the IM chat session and to save the IM chat transcript in response to receiving the indication to save the IM chat transcript. However, Lehman teaches the code adapted to instruct a programmable (page 10, fig. 105 - the dialog box instructing the user to save the chat history) device to receive an indication to save the IM chat transcript of an IM chat session (page 10 - fig. 105) and the code adapted to instruct a programmable device to save an IM chat transcript in response to receiving indication to save the IM chat transcript (page 10 - fig.104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul by having a computer-readable code adapted to instruct a programmable device to receive an indication to save an IM chat

transcript of the IM chat session and to save the IM chat transcript in response to receiving the indication to save the IM chat transcript as taught by Ertugrul in order to provide a reminder/option to save a historical record of the IM chat session.

As claim 16, Ertugrul teaches a system comprising: means for providing an email compose interface for composing an email message (fig.2, label 200; par [0034]; par [0011]), the email compose interface configured to designate at least one email recipient (fig. 2, label 212; par [0035], lines 2-4), the email compose interlace including an email send option for sending the email message (par [0025], lines 11-13; par [0028], lines 9-11, that by pressing the button, the email will be sent out) to the email recipient (fig. 8, labels 802, 806; par [0100], lines 1-5), the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option (fig. 2, labels 202,214; par [0032-33, 40, 43 and 93) receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface (par [0100], lines 3-12; par [0104], lines 14-17). Ertugrul does not teach the means for receiving an indication to save an IM chat transcript of the IM chat session and means for saving the IM chat transcript in response to receiving the indication to save the IM chat transcript.

However Lehman teaches the means for receiving an indication to save an IM chat transcript of the IM chat session (page 10 - fig. 105) and means for saving the IM chat transcript in response to receiving the indication to save the IM chat transcript (page 10 - fig. 104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul by having the means for receiving an indication to save an IM chat transcript of the IM chat session and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript as taught by Lehman in order to provide a reminder/option to save a historical record of the IM chat session.

As claim 17, Ertugrul teaches a system comprising: a provide component configured (par [0011]) to provide an email compose interface for composing an email message (fig. 2, label 200; par [0034]), the email compose interface configured to designate at least one email recipient (fig. 2, label 212; par [0035], lines 2- 4), the email compose interlace including an email send option for sending the email message (par [0025], lines 11-13; par [0028], lines 9-11, that by pressing the button, the email will be sent out) to the email recipient (fig. 8, labels 802, 806; par [0100], lines 1-5), the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option (fig. 2, labels 202,214; par [0032-33, 40,

43 and 93) a first receive component configured to receive an indication to launch an IM chat session with the at least one recipient of the email message from the email compose interface (par [0100], lines 3-12; par [0104], lines 14-17). Ertugrul does not teach a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session and a save component configured to save the IM chat transcript in response to receiving the indication to save the IM chat transcript.

However Lehman teaches a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session (page 10 - fig. 105) and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript (page 10 - fig. 104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul by having a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session and saving the IM chat transcript in response to receiving the indication to save the IM chat transcript as taught by Lehman in order to provide a reminder/option to save a

As claims 2, 10 and 18, Ertugrul does not teach receiving an indication to terminate the IM chat session prior to receiving the indication to save the IM chat transcript; providing a prompt in response to receiving the indication to terminate the IM chat session, the prompt comprising: an indication to save the IM chat transcript; and an indication to not save the IM chat transcript; wherein receiving the indication to save the IM chat

transcript is responsive to providing the prompt. However, Lehman teaches: receiving an indication to terminate the IM chat session prior to receiving the indication to save the IM chat transcript (page 10, Section options, first paragraph – Lehman teaches prompting the user to save the history in response to an indication to close the chat window; wherein the indication to terminate is the close command for the window); providing a prompt in response to receiving the indication to terminate the IM chat session (page 10- fig. 105), the prompt comprising: an indication to save the IM chat transcript; and an indication to not save the IM chat transcript (page 10 - fig. 105); and wherein the step of receiving the indication to save the IM chat transcript is responsive to the step of providing the prompt (page 10 - fig. 105). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul by receiving an indication to terminate the IM chat session prior to receiving the indication to save the IM chat transcript; providing a prompt in response to receiving the indication to terminate the IM chat session, the prompt comprising: an indication to save the IM chat transcript; and an indication to not save the IM chat transcript; wherein receiving the indication to save the IM chat transcript is responsive to providing the prompt as taught by Lehman in order to provide a reminder/option to save a historical record of the IM chat session.

As claims 7, 14 and 22, Ertugrul does not teach saving the IM chat transcript as text file. However, Lehman teaches saving the IM chat transcript as text file (page 9-10, Section Chat History, fourth paragraph; fig. 104). Therefore, it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify Ertugrul by saving the IM chat transcript as text file as taught by Lehman in order to provide a historical record of the IM chat session in a more compatible format.

3. Claims 3-5, 11-12 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul and Lehman in view of Kusuda (US Pub 2003/0088623), hereinafter "Kusuda"

As claims 3, 11 and 19, Ertugrul and Lehman, do not teach saving the IM chat transcript as an IM chat window. However, Kusuda teaches saving the IM chat transcript as an IM chat window (fig. 2; fig. 3, label 412; fig. 4, labels 11,320 and 314; fig. 5; par [0057]-[0058]; [0115]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul and Lehman by saving the IM chat transcript as an IM chat window as taught by Kusuda in order to save IM Chat session in Hypertext Markup Language (HMTL) is a benefit giving the user the ability to save the text and embedded images from an IM chat session for historical purposes and further after saving allow the chat session to be viewed in a freely available web browser.

As claim 4, Ertugrul and Kusuda do not teach the IM events being selected from a group consisting of: a list of participants in the IM chat session. However, Lehman teaches the IM events being selected from a group consisting of: a list of participants in the IM chat session (page 4 - fig. 101). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul and Kusuda by having a list of participants in the IM chat session as taught by Lehman in order to provide an IM chat session to a specified group and controlling access to the chat for those requiring access to the information.

As claims 5, 12 and 20, Ertugrul and Kusuda do not teach converting the IM chat transcript as text file. However, Lehman teaches converting the IM chat transcript to a text file (page 9-10, Section Chat History, fourth paragraph; fig. 104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul and Kusuda by converting the IM chat transcript as text file as taught by Lehman in order to provide a historical record of the IM chat session in a more compatible format.

4. Claims 6, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul, Lehman and Kusuda in view of Gusler et al. (US Pub 2003/0105815), hereinafter "Gusler".

As claims 6, 13 and 21, Ertugrul, Lehman and Kusuda do not teach converting the IM chat transcript to an email message. However, Gusler teaches converting the IM chat transcript to an email message (par [0041]-[0042], the IM messages are capable of being apart of e-mail to be sent out). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul, Lehman and Kusuda by converting the IM chat transcript to an email message as taught by Gusler in order to communicate a copy of the transcript to a parent, guardian or other designated representative allowing them to examine the transcript to determine if inappropriate contacts are occurring.

5. Claims 8, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul and Lehman in view Gusler.

As claims 8, 15 and 23, Ertugrul and Lehman do not teach saving the IM chat transcript as an email message. However, Gusler teaches saving the IM chat transcript as an email message (par [0041], the IM messages are saved in a log and the log can be placed in an e-mail to be sent out). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ertugrul and Lehman by saving the IM chat transcript as an email message as taught by Gusler in order to communicate a copy of the transcript to a parent, guardian or other designated

representative allowing them to examine the transcript to determine if inappropriate contacts are occurring.

(Note:) It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Response to Arguments

Applicant's arguments filed 02/01/2008 have been fully considered but they are not persuasive.

After careful review of the amended claims (given the broadest interpretation) and the remarks provided by the Applicant along with the cited reference(s) the Examiner does not agree with the Applicant for at least the reasons provided below:

A1. Applicant argues that Ertugrul does not teach that the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option.

R1. Examiner does not agree, Ertugrul clearly teaches that the email compose interface being configured for a user to input a message in the email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option. In paragraph 32-33 it is explained that

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there are two distinct interfaces, one for e-mail and one for instant messaging, in such that a button is apart of the e-mail interface that allows the user to initialize an instant messaging client, as further explained in paragraph 40 a button exist that allows user interaction to start an instant messaging session, then further in an alternative embodiment in paragraph 43 the user can use a third party application (AOL INSTANT MESSENGER) to run off from the e-mail interface, thus two separate interfaces that is ran off of one. Also note paragraph 93. It is clearly described that Ertugrul provides an e-mail compose interface being configured for a user to input a message (e-mail) into the e-mail compose interface and the instant messaging option (button) is associated with the sender or receiver to have an instant messaging session launched upon user or system interaction depending on user desired settings.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Augustine whose telephone number is 571-270-1056. The examiner can normally be reached on Monday - Friday: 7:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Augustine/
Examiner
Art Unit 2179
May 8, 2008

/Ba Huynh/
Primary Examiner, Art Unit 2179